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Docket No.: 58511-016

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

On re Application of :

Christian MAYAUD :

Serial No.: 09/201,107 :

Group Art Unit: 2165

Filed: November 30, 1998 :

Examiner: M. Kemper

For: PRESCRIPTION MANAGEMENT SYSTEM

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PETITION TO THE GROUP DIRECTOR UNDER 37 CFR 1.181(a)

Commissioner for Patents
Washington, DC 20231

Sir:

This is a petition to the Group Director from the holding of the Examiner that the dependent claims stand or fall with the independent claims.

On August 28, 2001 the Examiner mailed an Examiner's Answer in response to Appellant's Appeal Brief filed June 11, 2001. In that Answer, on page 2, the Examiner held that the dependent claims under rejection stand or fall together with the independent claims.

The Examiner's holding is contrary to law. The Appeal Brief devoted at least one paragraph to each claim and identified the distinctive element(s) not shown in the prior art. The Court has found such reasons sufficient to satisfy the terms of the Rule. *In re BEAVER*, 893 F.2d 329, 13 USPQ2d 1409 (1989 Fed.Cir.).

In *In re Beaver*, the Court reversed a holding by the Board of Patent Appeals and Interferences. In arguing dependent claims, Beaver listed at least one element of the

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dependent claims and several times asserted "Obviously, neither [reference] discloses" the recited element. The Board held that Beaver had not preserved the independent appeal of claims because "we do not consider a summary of the subject matter of claims 21 through 32 as a separate argument" (*Ibid.*, 1410). The Court found, "Although concise, the arguments pointed out the essential elements as compared with prior claims, and the inapplicability of the cited references, which had previously been discussed in the brief" (*Ibid.*, 1410).

The Court also addressed the special nature of dependent claims, and stated, "The subordinate claims by their nature required fewer words of explanation on appeal. . . . That Beaver did not repeat, in his argument for the subordinate claims, everything he had already said in arguing his principal claims did not convert 'dependent' claims into nonentities." (*Ibid.*, 1410, 1411).

In reversing the Board, the Court held, "There is no basis whatsoever for . . . the Board's holding that no claim after claim 20 had been separately argued" (*Ibid.*, 1411).

The Argument section of the Appeal Brief contains a reason for each independent claim and the inapplicability of the cited references, sometimes referring to reasons "which had previously been discussed in the brief" as found sufficient in *In re Beaver* above. The Appeal Brief also points out the distinct features of each dependent claim that are not found in the prior art references. Such reasons were found sufficient for the claims to stand or fall separately in *In re Beaver*, above. Therefore, the arguments are proper and each claim stands or falls independently of any other claim.

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Applicant respectfully requests that the Group Director reverse the Examiner's holding and direct that the claims be treated as separately argued.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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